

REMARKS

I. Introduction

Upon entry of the present amendment, claims 1, 3-8, 10-38, 41, 42, 47, 49, 51, 53, 56, 67, 59, 61, 63, 66-69, 71, 73, 74 and 76 will be pending in this application. Claim 1, 13, 15, 16 have been amended to recite that a concave surface of the cup body wall extends distally to a greater extent adjacent the superior and posterior flanges than at other positions around the rim of the cup. Claims 14, 23, 27, 29-33, 35, 37, 38, 47, 49, 51, 53 and 76 have been amended to recite the phrase "cup body" as described in the specification and the figures. Claim 56 has been amended to recite a liner. No new matter has been added.

Because the present amendments (1) do not raise new issues requiring further consideration or search, (2) do not introduce new matter, (3) materially reduce the issues for appeal, and (4) place this application into better condition for allowance, entry is appropriate under 37 C.F.R. § 1.116, and is respectfully requested.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

II. Objections to the Claims

The Examiner has noted that the amendment filed in response to the Office action mailed on July 23, 2004 failed to comply with 37 C.F.R. § 1.173. Applicants thank the Examiner for his careful reading of the claims. Applicants have made the necessary corrections to the claims included with this Response.

III. Rejections under 35 U.S.C. § 112

Claims 1, 3-8 and 10-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner states that the phrase “the wall” is indefinite in claims 1 and 13. Applicants have amended the claims to clarify that the cup body wall is the wall referenced.

IV. Rejections based on EP 0 663 193 A1 to Hermann et al.

The Examiner has rejected claim 23 under 35 U.S.C. § 102(b) as being anticipated by EP 0 663 193 A1 to Hermann et al.

The claims of the application are directed to an acetabular cup prosthesis that includes a cup body with a concave surface, a convex surface and an annular rim. The prosthesis includes a flanged portion extending away from the rim that helps attach the cup body to a patient's pelvis. The prosthesis also includes a surface of the cup body that extends distally to a greater extent adjacent the flange. This surface acts as a buttress that helps secure a mass of cement in between the cup body and a polymeric liner.

Applicants have amended claim 23 to clarify that the portion of the cup body acting as a buttress is a concave surface of the cup body wall extending distally to a greater extent adjacent the flange. *Hermann et al.* fails to teach a portion of the cup body extending distally to a greater extent. Thus, *Hermann et al.* fails to teach all the elements of the claims. Applicants respectfully request reconsideration and withdrawal thereof.

The Examiner has rejected claims 24-34 under 35 U.S.C. § 103(a) as being unpatentable over EP 0 663 193 A1 to Hermann et al. The Examiner states that limitations of claims 24-34 would have been obvious to those of skill in the art. Applicants respectfully submit that the amendment to claim 23 clarifies Applicants' invention. Even if the limitations taught by claims 24-34 were obvious to those with skill in the art, making these changes to the cementless acetabular cup of *Hermann et al.* would not teach Applicants' invention. As explained above, *Hermann et al.* fails to teach a portion of the cup body extending distally to a greater extent. Thus, Applicants respectfully request reconsideration and withdrawal thereof.

V. Rejections based on FR 2 660 546 A to Balay et al.

The Examiner has rejected claims 35, 36, 38, 41, 42, 47, 49, 51, 53, 56, 57, 59, 61, 63, 66 and 76 under 35 U.S.C. § 103(a) as being unpatentable over FR 2 660 546 A to Balay et al.

Applicants have amended the claims to recite a cup body as described and shown in the specification and drawings. The specification clearly describes the cup body as a separate from a liner, such as a polyethylene liner. The drawings show that the cup body 10A is separate from the liner 11. The Examiner has stated that the cup member is seen as comprising the cup assembly 4 and the hemispherical insert 5. However, Applicants respectfully submit that the amendments to the claims clarify that the cup body is separate from the liner and that it is the cup body which has an inner concave surface extending distally from the rim plane to a greater extent adjacent the superior and posterior flanges than

at other positions around the rim of the cup. The cup assembly of *Balay et al.* does not include these features and it is not possible to modify the cup assembly 4 of *Balay et al.* to achieve the claimed invention.

The Examiner's proposed modification to *Balay et al.*, i.e., combining the cup assembly 4 and the hemispherical insert 5 to be a single member, would change the principle of operation of *Balay et al.* The operation of a hip implant generally requires a separate polyethylene insert to prevent wear between the acetabular cup and the femoral component. The proposed change would change the principle by which *Balay et al.* operates, therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01. The fact that these two parts are composed of different materials further underscores that the parts cannot in fact be combined to form one part. Therefore, Applicants submit that the claims of the application are not rendered obvious by *Balay et al.* and request reconsideration thereof.

VI. Allowable Claims

The Examiner has indicated that claims 1, 3-8 and 10-13 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner has indicated that claim 37 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner has indicated that claims 14-22, 67-69, 71, 73, and 74 are allowable over the prior art. Applicants thank the Examiner for his consideration of these claims.

CONCLUSION

In light of the amendments and the above remarks, Applicants are of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6409 is respectfully solicited.

Respectfully submitted,



Aleta A. Mills
Reg. No. 47,794

KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500
Docket: 10557/247605